UNITED STATES PATENT AND TRADEMARK OFFICE

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PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER
CHEN, TE Y

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1   UNITED STATES PATENT AND TRADEMARK OFFICE

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4   BEFORE THE BOARD OF PATENT APPEALS

5   AND INTERFERENCES

6   _____

7

8   *Ex parte* PARAG GOKHALE, RAJIV KOTTOMTHARAYIL,

9   and SRINIVAS KAVURI

10   _____

11

12   Appeal 2008-1254

13   Application 09/991,900[1]

14   Technology Center 2100

15   _____

16

17   Decided: April 11, 2008

18   _____

19

20

21   Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and

22   CAROLYN D. THOMAS, *Administrative Patent Judges.*

23

24   THOMAS, C., *Administrative Patent Judge.*

25

26   DECISION ON APPEAL

_____

[1] Application filed November 23, 2001. The real party in interest is
CommVault Systems, Inc.

1   I. STATEMENT OF THE CASE

2   Appellants appeal under 35 U.S.C. § 134 from a final rejection

3   of claims 1-20 entered January 20, 2006. We have jurisdiction under

4   35 U.S.C. § 6(b).

5   We reverse.

6

7   A. INVENTION

8   Appellants invented a system, method, and computer readable

9   medium for exporting media in a library according to a scheduled second

10   time. (Spec., Abstract.)

11

12   B. ILLUSTRATIVE CLAIM

13   The appeal contains claims 1-20. Claims 1, 12 and 18 are

14   independent claims. Claim 1 is illustrative:

15   1.   A method for exporting removable media in a storage
16   device according to a schedule, comprising:

17   at a first time, receiving export identification data
18   comprising first data identifying one or more removable media from
19   the storage device to be exported and second data identifying a second
20   time at which the one or more removable media is scheduled to be
21   exported;

22   storing the export identification data in a data file; and

23   at the second time, using the stored export identification
24   data to select the one or more removable media to be exported to
25   export the selected media from the storage device library.

26

1   C. REFERENCES

2   The references relied upon by the Examiner in rejecting the claims on

3   appeal are as follows:

4   Crouse   US 5,764,972   Jun. 9, 1998

5   Baca   US 5,898,593   Apr. 27, 1999

6

7   D. REJECTION

8   The Examiner entered the following rejection which is before us for

9   review:

10   Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being

11   unpatentable over Crouse in view of Baca.

12

13   II. PROSECUTION HISTORY

14   Appellants appealed from the Final Rejection and filed an Appeal

15   Brief (App. Br.) on March 19, 2007. The Examiner mailed an Examiner's

16   Answer (Ans.) on July 17, 2007. Appellants filed a Reply Brief (Reply Br.)

17   on September 17, 2007. A telephonic Oral Hearing was held at the U.S.

18   Patent and Trademark Office on April 8, 2008.

19

20   III. ISSUE

21   Whether the combination of Crouse and Baca would have suggested

22   exporting media according to a scheduled second time.

23

24   IV. FINDINGS OF FACT

25   The following findings of fact (FF) are supported by a preponderance

26   of the evidence.

1   *Baca*

2   1. Baca discloses "an automated data storage library for storage,

3   retrieval, selective export and import of portable data storage media, at least

4   some of the media stored in storage cells of portable magazines." (Col. 2, ll.

5   3-6.)

6   2. In Baca, "the library controller 82 is able to employ a cartridge

7   identifier in a command from a host 85 to identify the magazine containing

8   the cartridge, and the storage slot location of the cartridge, determine the

9   location of any cartridge in a drive, and the current position of the pickers.

10 This information is used in conjunction with job queue contents by the

11 library manager to schedule picker moves and to schedule the export of

12 selected magazines." (Col. 6, l. 62 to Col. 7, l. 3.)

13   3. Baca discloses that "[w]hen a magazine is required to be exported,

14 the host will instruct the operator that a selected magazine is ready to be

15 exported and indicate the column 90 or 91 which has the selected

16 magazine." (Col. 7, ll. 43-46.)

17

18   V. PRINCIPLES OF LAW

19   Appellants have the burden on appeal to the Board to demonstrate

20 error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86

21 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a

22 rejection [under § 103] by showing insufficient evidence of *prima facie*

23 obviousness or by rebutting the *prima facie* case with evidence of secondary

24 indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355

25 (Fed. Cir. 1998)).

1   "Section 103 forbids issuance of a patent when 'the differences

2   between the subject matter sought to be patented and the prior art are such

3   that the subject matter as a whole would have been obvious at the time the

4   invention was made to a person having ordinary skill in the art to which said

5   subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,

6   1734 (2007). The question of obviousness is resolved on the basis of

7   underlying factual determinations including (1) the scope and content of the

8   prior art, (2) any differences between the claimed subject matter and the

9   prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called

10   secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18

11   (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these

12   questions might be reordered in any particular case, the [*Graham*] factors

13   continue to define the inquiry that controls.")

14

15   VI. ANALYSIS

16   *Common Feature In All Claims*

17   Our illustrative claim presented *supra*, claim 1, recites, *inter alia,* "at

18   a first time, receiving . . . second data identifying a second time at which the

19   one or more removable media is scheduled to be exported." Independent

20   claims 12 and 18 recite similar limitations. Thus, the scope of each of the

21   independent claims includes "the exportation of selected removable media at

22   a second time."

23   *The Obviousness Rejection*

24   We now consider the Examiner's rejection of claims 1-20 under

25   35 U.S.C. § 103(a) as being obvious over the combination of Crouse and

26   Baca.

1   The question of obviousness is "based on underlying factual

2   determinations including . . . what th[e] prior art teaches explicitly and

3   inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing

4   *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*,

5   175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed.

6   Cir. 1995)). "In rejecting claims under 35 U.S.C. § 103, the examiner bears

7   the initial burden of presenting a *prima facie* case of obviousness." *In re*

8   *Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d

9   1443, 1445 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is

10   established when the teachings from the prior art itself would appear to have

11   suggested the claimed subject matter to a person of ordinary skill in the art.'"

12   *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*,

13   531 F.2d 1048, 1051 (CCPA 1976)).

14   The Examiner found that "Crouse did not specifically disclose at the

15   second time, the file input/output commands including a scheduling of an

16   exporting processing." (Ans. 4.) Instead, the Examiner relies upon Baca for

17   this limitation and found that Baca "discloses a data storage system to

18   automatically scheduling [sic] an import and export I/O commands for

19   removable devices at the second time." (Ans. 5.)

20   Appellants contend that "Baca does not disclose exporting media

21   according to a schedule, as described in claim 1." (App. Br. 8.) Appellants

22   further contend that:

23   [T]he "scheduling" in Baca relates to coordinating specific
24   internal operations in the library, such as moving a picker and
25   rearranging stacks of magazines so that a desired magazine is
26   on top of a stack for exporting. The "scheduling" in Baca does
27   not disclose "identifying a second time at which the one or

1   more removable media is scheduled to be exported" as recited
2   by the claim.
3
4 (App. Br. 8-9.) We agree.
5
6   Baca discloses an automated data storage library that performs

7 selective export and import of portable data storage media (FF 1). In Baca, a

8 library controller receives a cartridge identifier in a command from a host

9 and uses this information in conjunction with the job queue contents to

10 schedule the export of selected magazines (FF 2). Baca's host instructs the

11 operator that a selected magazine is ready to be exported and indicates the

12 column that has the selected magazine (FF 3).

13   In other words, we find that while Baca discloses selectively

14 exporting data storage media using an identifier found in a command from a

15 host in conjunction with job queue information, the Examiner has not

16 shown, and we do not readily find where Baca makes up for the deficiencies

17 of Crouse and discloses receiving a second time and at the second time

18 exporting the selected media from the storage. Instead, Baca relies in part

19 on the job queue list to determine the exportation time, which is in essence a

20 time dictated by "as soon as possible". We find that a "time" hinging on "as

21 soon as possible" is distinguishable from "second data identifying a second

22 time at which the one or more removable media is scheduled to be

23 exported," as recited in the language of independent claim 1.

24   Since we agree with Appellants that the Examiner has not supported

25 the rejection of the noted claims with a teaching or suggestion from the cited

26 prior art, and as the above-noted arguments affect all the appealed claims, it

27 is not necessary at this time to address the further arguments made by

28 Appellants (e.g., App. Br. 10 and Reply Br. 5).

1   Therefore, we will *not* sustain and will instead reverse the Examiner's

2 rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

3

4   VII. CONCLUSION

5   We conclude that Appellants have shown that the Examiner erred in

6 rejecting claims 1-20.

7

8   VIII. DECISION

9   In view of the foregoing discussion, we reverse the Examiner's

10 rejection of claims 1-20.

11   <u>REVERSED</u>
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15 clj
16
17 PERKINS COIE LLP
18 PATENT-SEA
19 P.O. BOX 1247
20 SEATTLE, WA 98111-1247
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